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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/556,647	04/24/2000	Mitchell R. Bauer	8778.00	7493

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EXAMINER

FISCHER, ANDREW J

ART UNIT PAPER NUMBER

3627

DATE MAILED: 03/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/556,647

Applicant(s)  
Mitchell B. Bauer

Examiner  
Andrew J. Fischer

Art Unit  
3627



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jan 14, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 and 31-39 is/are pending in the application.
- 4a) Of the above, claim(s) 1-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22 and 31-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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## DETAILED ACTION

### *Acknowledgments*

1. The amendment filed January 14, 2003 (Paper No. 11) is acknowledged. Accordingly, claims 1-22 and 31-39 remain pending with duplicate claim 22 (the second claim 22) having been canceled.

2. Applicant's election with traverse of Group IV (claim 22 and 31-39) in Paper No. 11 is acknowledged. The traversal is on the ground(s) that querying the user is a different process at all, let alone materially different process. This is not found persuasive because Applicant has not argued that the processes are "patentably distinct." Although a subtle distinction, it is the Examiner's position that "patentably distinct" is a term of art usually different in meaning than "materially different." Moreover, Applicant previously argued the claims were patentably distinct.<sup>1</sup>

a. Additionally, the Examiner is unaware of the substantially "substantially verbatim" standard. Claims substantially verbatim may nevertheless be patentably distinct.<sup>2</sup> In this case, the elected Groups consists of language *potentially* invoking 35 U.S.C. 112 6<sup>th</sup> paragraph.

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<sup>1</sup> See the previous Office Action mailed December 17, 2002, Paper No. 9, Paragraph No. 3.

<sup>2</sup> See e.g. *Generation II Orthotics Inc. v. Medical Technology Inc.*, 59 USPQ2d 1919, 1929 (Fed. Cir. 2001) ("The mere fact that a method claim is drafted with language parallel to an apparatus claim with means-plus-function language does not mean that the method claim should be subject to an analysis under §112, paragraph 6. Rather, each limitation of each claim must be independently reviewed to determine if it is subject to the requirements of §112, paragraph 6.")

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3. The Examiner has considered all arguments of record and finds that they are not persuasive. The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the Applicant regards as his invention.

5. Claims 22 and 31-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

a. In claim 22, it is unclear whether the applicant is claiming the subcombination of the apparatus or the combination of the apparatus and the computer system.

If the applicant's intent is to claim only the subcombination, the body of the claim(s) must be amended to remove any positive recitation of the combination. If the applicant intends to claim the combination (i.e. include the computer system), the Examiner respectfully requests Applicant to clarify this matter by indicating it as so. For purposes of *appeal only*, the Examiner has interpreted the claim as a combination claim.

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***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the Applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the Applicant for patent.

7. Claims 22, 31-33, and 39, as understood by the Examiner, are rejected under 35 U.S.C. 102(e) as being anticipated by Salvo et. al. (U.S. 6,341,271 B1) ("Salvo"). Salvo discloses means for storing (the hard drive or permanent memory associated with control unit 114); means for populating a plurality of filter lists (the computer the customer's use to input their desired product such as site controller 112); means for displaying a material browser (a computer monitor inherent in any computer); means for selecting one of the computer lists (again an ordinary personal computer having a mouse); means for filtering (the CPU associated with control unit 114); the display means is configured for displaying; mean for sorting a filtered list (again inherent within virtually any personal computer including controller 114).

8. Functional recitation(s) using the word "for" (e.g. "for displaying in said browser said filtered list of raw materials matching said filter criterion") have been considered but are given little patentable weight<sup>3</sup> because they fail to add any structural limitations and are thereby

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<sup>3</sup> See e.g. *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that although all limitations must be considered, not all limitations are entitled to patentable weight.).

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regarded as intended use language. A recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) (“The manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself.”); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 2114 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in this paragraph apply to all examined claims currently pending.

a. By way of example only, the Examiner suggests simply “displaying” instead of “configured for displaying” if a positive recitation is desired.

9. Claim 22 begins “An apparatus . . . .” Additionally, “[c]laims in apparatus form conventionally fall into the 35 U.S.C. §101 statutory category of a ‘machine.’” *Ex parte Donner*, 53 USPQ2d 1699, 1701 (B.P.A.I. 1999)(unpublished), (Paper No. 34, page 5, issued as U.S. Patent 5,999,907). Products may be either machines, manufactures, or compositions of matter. MPEP §2106 IV B. 2 (a). Therefore, it is the Examiner’s position that Applicant’s apparatus claims are clearly “product” claims or more specifically, “machine” claims. Next, claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. See *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). With this in mind, Applicant is reminded that “apparatus claims cover what a device is, not what a device does.”

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*Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

10. The Examiner notes that Applicant has decided not to be his own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings. Specifically, after receiving notice in the previous Office Action<sup>4</sup> of the Examiner's position that lexicography is *not* invoked, Applicant has failed to point out the "supposed errors" in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b) (i.e. Applicant has failed to argue lexicography *is* invoked). Also support of the Examiner's position that Applicant is not his own lexicographer, it is the Examiner's factual determination that not only has Applicant failed to point to definitional statements in his specification or prosecution history, Applicant has also failed to point to a term or terms in a claim with which to draw in those statements.<sup>5</sup> Finally and to be sure of Applicant's intent, the Examiner also notes that Applicant has declined the Examiner's express invitation<sup>6</sup> to be his own

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<sup>4</sup> See the Examiner's previous Office Action mailed August 2, 2002, Paper No. 5, Paragraph No. 10.

<sup>5</sup> "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, at the very least, point to a term or terms in the claim with which to draw in those statements." *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

<sup>6</sup> See again the Examiner's previous Office Action Paper No. 5, Paragraph No. 10.

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lexicographer.<sup>7</sup> Accordingly and for due process purposes, the Examiner gives notice that for the remainder of the examination process and unless 35 U.S.C. 112 6<sup>th</sup> paragraph applies (as discussed below), the heavy presumption in favor of the ordinary and accustomed meaning is not overcome; the claims therefore continue to be interpreted with their “broadest reasonable interpretation . . . .” *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).<sup>8</sup> The Examiner now relies heavily and extensively on this interpretation.<sup>9</sup> See e.g. *Transclean Corp. v. Bridgewood Servs., Inc.*, 290 F.3d 1364, 1381, 62 USPQ2d 1865, 1877 (Fed. Cir. 2002) (“Because the patentee has not chosen to be his own lexicographer in this instance, [the claimed element] should carry its ordinary meaning . . . .”)(Clevenger, J. dissenting in part). Unless expressly noted otherwise by the Examiner, the preceding claim interpretation principles in this paragraph apply to all examined claims currently pending.

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<sup>7</sup> The Examiner’s request on this matter was reasonable on at least two separate and independent grounds: first, the Examiner’s request was simply an express request for clarification of how Applicant intend his claims to be interpreted so that lexicography (or even an *attempt* at lexicography) by Applicant was not inadvertently overlooked by the Examiner. Second, the requirements were reasonable in view of the USPTO’s goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO’s The 21<sup>st</sup> Century Strategic Plan, February 3, 2003 available at [www.uspto.gov/web/offices/com/strat21/index.htm](http://www.uspto.gov/web/offices/com/strat21/index.htm) (last accessed March 23, 2003).

<sup>8</sup> See also MPEP §2111 and §2111.01; *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc).

<sup>9</sup> See 37 C.F.R. §1.104(c)(3) which states in part: “the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability . . . . [Emphasis added.]”



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11. Although Applicant uses “means for” in the claims (e.g. “means for storing” as recited in claim 22), it is the Examiner’s position that the “means for” phrases do not invoke 35 U.S.C. 112 6<sup>th</sup> paragraph. If Applicant concurs, the Examiner respectfully requests Applicant to either amend the claims to remove all instances of “means for” from the claims, or to explicitly state on the record why 35 U.S.C. 112 6<sup>th</sup> paragraph should not be invoked.

Alternatively, if Applicant desires to invoke 35 U.S.C. 112 6<sup>th</sup> paragraph, the Examiner respectfully requests Applicant to expressly state his desire on the record. Upon receiving such express invocation of 35 U.S.C. 112 6<sup>th</sup> paragraph, the “means for” phrases will be interpreted as set forth in the *Supplemental Examination Guidelines for Determining the Applicability of 35 USC 112 6<sup>th</sup>*.<sup>10</sup>

Failure by Applicant to address the 35 U.S.C. 112 6<sup>th</sup> paragraph issues in the manner set forth above or to be non-responsive to this issue entirely will be considered a desire by Applicant NOT to invoke 35 U.S.C. 112 6<sup>th</sup> paragraph. As an exception to the “broadest reasonable interpretation” as noted in Paragraph No. 10 above, the preceding discussion on 35 U.S.C. 112 6<sup>th</sup> paragraph applies to all examined claims currently pending.

### ***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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<sup>10</sup> Federal Register Vol 65, No 120, June 21, 2000.

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 22, 31-33, and 39, as understood by the Examiner, are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Salvo.<sup>11</sup> It is the Examiner's principle position that the claims are anticipated as discussed above because certain elements are inherent.

However if not inherent, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Salvo to include the inherent elements. Such a modification would have provided an express disclosure of what one of ordinary skill in the art would already know.

14. It is the Examiner's factual determination that all limitations in claims 22, 31-33, and 39 have been considered and are either disclosed or inherent in Salvo as discussed above.

Furthermore, the inherent features are established by a preponderance of the evidence. *In re Epstein*, 32 F.3d 1559, 1564, 31 USPQ2d 1817, 1820 (Fed. Cir. 1994) ("Preponderance of the evidence is the standard that must be met by the PTO in making rejections." (citations and quotations omitted)). The preceding discussion in this paragraph regarding the standard for claim rejections applies to all examined claims currently pending.

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<sup>11</sup> See MPEP §2112 expressly authorizing alternative 102/103 rejections when the question of inherency is present in the §102 rejection.

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*Response to Arguments*

15. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground of rejection.

16. Additionally, because of the change in Applicant's attorney of record, the Examiner will not expound on Applicant's somewhat cantankerous arguments as stated in the response filed October 21, 2002 (Paper No. 8).

*Conclusion*

17. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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18. Unless expressly noted otherwise within this Office Action, the following two citations to the Manual of Patent Examining Procedure ("MPEP") apply: MPEP citations to Chapters 200, 700, 1800, and 2100 are from the MPEP 8<sup>th</sup> Edition, Rev 1, February 2003. All remaining MPEP citations within this Office Action are from the MPEP 8<sup>th</sup> Edition, August 2001.

19. The Examiner notes at least two courtesy calls were made on or about February 12, 2002 and March 5, 2002 to Applicant in an effort to allow the application. It is the Examiner's position that every effort was made to position the case for allowance before the application became Final. Specifically, the Examiner stated claims 34 and 35 (in addition to any claims dependent upon these claims) were allowable and invited Applicant to file a supplemental amendment to get the application in condition for allowance. As of the date below, Applicant has declined to exercise this option.

20. Because this application is now final and because of the Examiner's attempt to place this application in condition for allowance as noted in the paragraph directly above, Applicant is reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that the claim is "allowed," exemplary claim language provided

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by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (e.g. §101 patentable subject matter, §112 1<sup>st</sup> paragraph written description and enablement, §112 2<sup>nd</sup> paragraph antecedent basis and indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as described above.

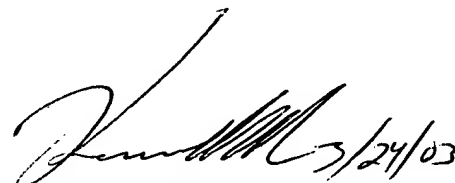
21. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicant with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicant for his “Remarks” (Paper Nos. 8 and 11 respectively) traversing the Examiner's positions on various points. If Applicant disagrees with any additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied<sup>12</sup>, the Examiner respectfully requests Applicant *in his next properly filed response* to expressly traverse the Examiner's position and provide appropriate arguments in support thereof. By addressing these issues now, matters where the Examiner and Applicant agree can be eliminated allowing the

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<sup>12</sup> E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.

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Examiner and Applicant to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicant has *any* questions regarding the Examiner's positions or has other questions regarding this communication or even previous communications, Applicant is strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292.

  
Kenneth R. Rice  
Primary Examiner

  
ANDREW J. FISCHER  
PATENT EXAMINER

AJF  
March 23, 2003